

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

Citing MPEP §806.04 and MPEP §808.01, the Office has characterized Groups II to be unrelated to Groups I and III-IV. However, Applicants note that the MPEP describes unrelated inventions as, for example, "an article of apparel such as a shoe, and a locomotive bearing", or "a process of painting a house and a process of boring a well." MPEP 806.04(A). Thus, unrelated inventions, as defined by the MPEP, are inventions which are directed to *completely* different technical fields, and have no reasonable relationship with each other. Applicants make no statement regarding the patentable distinctness of the inventions of Groups I-V, but note that Groups I-V can be reasonably be searched in the same technical field. In fact Groups I -IV are classified in the same class 435. Thus the inventions of Groups I -V of the present invention do not meet the standard of "unrelatedness" of MPEP 806.04(A), discussed above, nor do they present a burden on the Office. Accordingly, Applicants respectfully submit that the Restriction is improper, and request that it be withdrawn.

In regard to Groups I and Groups III-IV, the Office has characterized the relationship between these groups as product and process of use. Citing MPEP §806.05(h), the Office states that the product as claimed "can be used for a materially different process of using the product such as in the recombinant production of the encoded enzyme." Applicants note that the Office has merely stated an unsupported conclusion. The Office has failed to show that the alleged process "recombinant production of the encoded enzyme" is materially different

from the claimed process. Accordingly, Applicants respectfully submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction.

The Office has characterized Group I and Group V to be distinct and states that the claimed "protein product can be made by other and materially distinct processes, such as purification from a natural source" and the claimed "DNA product can be used for processes other than the production of protein, such as nucleic acid hybridization assays." Applicants respectfully submit that the Office has failed to show that the alleged process is materially different from the claimed process, and has merely stated a conclusion. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

In regard to Groups I and IV, the Office has characterized these groups as unrelated. The Office alleges that "these methods are distinct because they use wholly different reagents and wholly different method steps to produce wholly distinct products." However, Applicants respectfully submit that the Office has not provided any explanation/examples whatsoever. Therefore the Office has merely stated an unsupported conclusion. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

For Groups III and IV, the Office has characterized these groups as unrelated. The Office alleges that "the polypeptide is neither used nor produced in the claimed methods." Applicants note that the Office has not provided any explanation/examples to support its conclusion. Accordingly, Applicants respectfully submit that the restriction requirement is improper, and it should therefore be withdrawn.

In addition, Applicants respectfully traverse the Requirement for Restriction on the grounds that the Office has not shown that a burden exist in searching all of the claims.

Applicants respectfully point out Groups I-IV are in classified in class 435 and could be searched together.


Finally, Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected claims should be rejoined.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Withdrawal of the Requirement for Restriction is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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